

10/666,090

02074/02091

Remarks

Applicants have amended claim 1 and added new claims 29 and 30 to more clearly point out the invention. These amendments are not the addition of new matter, nor do they raise new issues. See page 8, lines 4 – 12 and page 19, lines 7 – 10 of the specification. Accordingly, Applicant respectfully ask that the amendments be entered.

Applicants respectfully traverse the rejection of claims 4 and 13 under 35 U.S.C. §112, second paragraph.

Applicants respectfully submit that not all silica is diatomaceous earth. Diatomaceous earth is just one form of silica.

Silica (SiO_2) is silicon dioxide. It occurs widely in nature as sand, quartz, fling, diatomite. Diatomaceous earth is a diatomite (kieselguhr; infusorial earth). Typically, diatomaceous earth is a solid material of 88% silica. "Celite" is a trademark (brand name) for diatomaceous earth and related products.

Clearly, diatomaceous earth and silica are well recognized in the industry and are not unclear. Not all silica is diatomaceous earth. See Hawley's Condensed Chemical Dictionary, 14 Ed., 2002, Richard J. Lewis, Sr.

Accordingly, Applicants respectfully ask that the Examiner withdraw this rejection under 35 U.S.C. §112.

Applicants also respectfully traverse the rejection of claims 1 – 17 and 28

are rejected under 35 U.S.C. §103(a) over Lam, US Patent 6,001,750, in view of US patent 6,630,416 to Lam.

Claims 1 – 4, 6 – 17 and 28 – 30, as amended, patentably distinguish over the Lam '750 and Lam '416 in the recitation of a second layer comprising 0.2% to 50%, by weight, of symmetrically shaped silica particles, based on the total weight of the friction modifying particles.

Nowhere do Lam '750 and Lam '416 taken alone or collectively disclose or suggest this.

The Examiner argues that the geometrically symmetric shape is intrinsic and that Applicants are merely claiming the shape of the particles used in the prior art. Pages 18 and 19 of Applicants' specification show that this is not the case.

Lam '750 does not disclose a fibrous base material and a secondary layer of carbon particles positioned on at least one surface of the fibrous base material for use as a friction material. Lam '750 does not dictate the shape of the carbon particles that are used on the secondary layer. There is nothing in Lam '750 that discloses or suggests that the carbon particles on the secondary layer are geometrically symmetrically shaped as defined in Applicants' claimed invention.

Lam '416, likewise, does not disclose or suggest the use of geometrically symmetrically shaped friction modifying particles as set forth in Applicants' claims.

Applicants respectfully submit that there is no factual basis on which to

base obviousness. The Examiner has provided no extrinsic evidence to establish inherency. The inherency argument attempts to add to the references what is not there.

The deficiencies of the references have been discussed. Applicants respectfully submit that not only is there an absence of a suggestion, but also an absence of the key elements of the claims. Nowhere do the cited references disclose the key elements of the claims. The absence in and of itself is sufficient to conclude that no case of obviousness had been established.

To establish inherency, the Examiner must provide extrinsic evidence making clear that the missing descriptive matter is necessarily present in the reference, and that it would have been so recognized by persons of ordinary skill. See In re Robertson, 49 USPQ2d, 1949 (Fed.Cir. 1999). Inherency may not be established by probabilities or possibilities.

The inherency argument attempts to add to the references what is not there. The Examiner has failed to make out a *prima facie* case of obviousness, see In re Stemniski, 170 USPQ 343, (CCPA 1971). There is no factual basis on which to base obviousness.

Applicants respectfully submits the naturally occurring materials, e.g., silica or diatomaceous earth, would be highly irregular instead of symmetrical. Column 9, lines 20 – 35 of Lam '416, relied upon by the Examiner, states that the silica

particles provide high coefficients of friction. If anything, this suggest irregular shapes rather than symmetrical shapes.

Further, the carbon particles disclosed in Lam '750 are not geometrically symmetrically shaped particles. It was not until the invention covered by the present patent application that the advantages of such geometrically symmetrically shaped particles was appreciated. As set forth on page 19, lines 1 – 4, the geometrically symmetrically shaped friction modifying particles are relatively expensive and would not be utilized in the secondary layer without an express understanding of the advantages provided by friction modifying particles containing this unique shape. As indicated on page 18, lines 20 – 31, Applicants' disclose the use of geometrically symmetrically shaped particles and irregularly shaped friction modifying particles for the secondary layer of the friction material. This disclosure further supports the fact that geometrically symmetrically shaped particles are a distinct and separate product from the irregularly shaped friction modifying particles that have been traditionally used in friction material.

The Examiner argues that the shape was present in the prior art since the same materials are used. Pages 18 and 19 of Applicants' specification show that this is not the case.

Applicants respectfully submits that no basis in fact or theory exists to support the Examiner's conclusion.

10/666,090

02074/02091

Naturally occurring materials such as silica, diatomaceous earth and even "Celite" brand silica would be if anything irregular. One has to go out of his way to use symmetrical materials.

New claims 29 and 30 are even more patentably distinct over the prior art.

The Examiner's analysis ignores the express limitations in the claims. This mode of claim interpretation disregards the claimed subject matter. See Bausch & Lomb, Inc. v. Barnes-Hind/Hydrocurve Inc. 796 F.2d 443, 448-449, 230 USPQ 416, 420 (Fed.Cir. 1986).

Applicants respectfully submits that one cannot rely on hindsight in reaching an obviousness determination. It is essential that the decision maker forget what he or she has been taught by the claimed invention. One cannot use hindsight reconstruction to arrive at the claimed invention. See In re Fine, 837 F2d 1071 5 USPQ 1596 (CAFC 1988).

Accordingly, Applicants respectfully ask that the Examiner withdraw this rejection under 35 U.S.C. §103.

10/666,090

02074/02091

Applicants respectfully submit that claims 1 – 4, 6 – 17 and 28 – 30 are in condition for allowance and respectfully ask that the Examiner pass the claims to issue.

Respectfully submitted,

EMCH, SCHAFER, SCHAUB
& PORCELLO CO., L.P.A.



Patrick P. Pacella
Reg. No. 25,463

P.O. Box 916
Toledo, Ohio 43697
Ph: (419) 243-1294
Fax (419) 243-8502
PPP/kab